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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,606	07/02/2003	Heinz-Juergen Dem	302.139	4791
47888	7590	04/19/2006	EXAMINER	
HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036			SALVATORE, LYNDIA	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 04/19/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/612,606

Applicant(s)

DERN ET AL.

Examiner

Lynda M. Salvatore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 4/05/06, 1/25/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-13, 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's request for continuing examination (RCE), amendment and accompanying remarks filed 1/25/06 and 4/05/06 have been fully considered and entered. Claim 10 has been amended and claim 14 has been canceled. Applicant's amendment to claim 10 is not found patently distinguishable over the prior art made of record and Applicant's arguments are not found persuasive of patentability reasons set forth herein below.

### ***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 10,12 and 15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1082236

Applicant amended claim 10 to recite that the substituted fatty acid amide having the formula presented in claim 10 is in a "methanol" solution. However, it should be noted that claim 10 recites the limitation of 1-15 wt.% of fatty acid amides *and/or* substituted fatty acid amides having the formula set forth in claim 10. As such, the Examiner considers the teaching in the GB disclosure to adding stearamide or oleamide (e.g., fatty acid amides) as loosening agents and softeners sufficient to meet the claim limitation of fatty acid amides. With regard to Applicant's argument that the GB specification is directed to an emulsion and not an alcoholic solution, is respectfully pointed out that Applicant is not claiming an alcoholic solution. As such, Applicant's arguments are not commensurate in scope with the claimed subject matter.

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Recall, the published GB specification teaches producing an aqueous emulsion suitable for impregnating textile substrates (Column 1, 61-65). The emulsion comprises novolak (i.e., phenol-formaldehyde) or a mixture of cresol and phenol (Column 2, 63-63-80 and Column 3, 45-50). Said resin is a thermo-hardening resin such that it hardens in the presence of heat (Column 5, 1-10). With regard to the fatty acid amide limitation, the published specification teaches adding loosening agents and softeners such as stearamide or oleamide (column 4, 105-115).

With regard to the weight percent limitations set forth in claim 10, the published GB specification fails to teach how much fatty acid amide is added, however, it is the position of the Examiner that it would be obvious to one having ordinary skill in the art at the time the invention was made to add a suitable amount of fatty acid amide as a function of desired softness. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233

4. Claims 11 and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1082236 in view of Wernik et al., US 6,372,878.

The published GB specification does not specifically teach the claimed resol binding composition, however, the patent issued to Wernik et al., teaches a modified resol binding resin composition (Abstract and Column 1, 50-59). The aqueous solution may comprise various phenolic compounds used singularly or in a mixture (Column 2, 33-40). The resin solution further comprises an aldehyde such as formaldehyde (Column 2, 41-50). In addition the resol binding resin may be further combined and cured with other polymers such as melamine,

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epoxide or polyvinyl (Column 3, 50-56). Wernik et al., specifically teaches that the resol binding resin is suitable as an impregnation agent, or binders for grinding abrasives on substrates (Column 3, 58-67). Advantages of the modified resol binding resin include good water-dilutability and bright curing at elevated temperatures without chemical and/or physical degradation of the cured product (column 1, 35-45).

Therefore, motivated by the desire to impregnate a textile with a binding agent which provides good water-dilutability and bright curing at elevated temperatures without chemical and/or physical degradation of the cured product, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the phenol based binder in the coating composition taught by the published GB specification with the modified resol binding resin taught by Wernik et al.

### *Conclusion*

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M. Salvatore whose telephone number is 571-272-1482. The examiner can normally be reached on M-F.

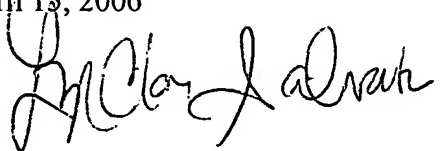
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 15, 2006

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A handwritten signature in black ink, appearing to read "M. Clay L. Drake". The signature is written in a cursive, flowing style.